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|-----------------|-------------|----------------------|---------------------|------------------|
| 10/658,307      | 09/09/2003  | Michiharu Yamamoto   | NDTCO.022A          | 2141             |

20995 7590 11/07/2005

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EXAMINER

KUGEL, TIMOTHY J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1712

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/658,307

Applicant(s)

YAMAMOTO ET AL.

Examiner

Timothy J. Kugel

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 13, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 13, 25 and 26 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1, 13, 25 and 26 are pending as amended on 20 October 2005, claims 2-12 and 14-24 being cancelled. Claims 25 and 26 are withdrawn from further consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Claims 25 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 19 May 2005.

### ***Oath/Declaration***

4. Applicant's new oath, filed 20 October 2005, has been fully considered and is corrective. The objection to the oath has been withdrawn.

### ***Specification***

5. Applicant's amendment, filed 20 October 2005, with respect to the correction of minor informalities has been fully considered and are corrective. The objection to the specification has been withdrawn.

### ***Double Patenting***

6. Applicant's arguments, filed 20 October 2005, particularly that the cited reference US 6,534,198 (Uneo) does not have an assignee in common with the instant application, have been fully considered and are persuasive.

The rejection of claim 1 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 9 of Uneo has been withdrawn.

***Claim Rejections - 35 USC § 102***

7. Applicant's Declaration under §1.132, filed 20 October 2005, particularly that the pertinent invention of references US 6,610,809 (Yamamoto '809) and US 6,653,421 (Yamamoto '421) were not "by another", have been fully considered and are persuasive.

Please note that applicant is correct in remarking that the reference US 6,953,421, rather than the correct reference US 6,653,421, was cited in a typographic error in the previous Office action. A Notice of References Cited form PTO-892 with the correct citation is attached to this Office action.

The rejection of claims 1 and 13 under 35 USC 102(e) as being anticipated by Yamamoto '809 has been withdrawn.

The rejection of claims 1 and 13 under 35 USC 102(e) as being anticipated by Yamamoto '421 has been withdrawn.

8. Applicant's arguments, filed 20 October 2005, particularly that Uneo teaches polymers having –Si–Si– bonds rather than the claimed –Si–O–Si– bonds, have been fully considered and are persuasive.

The rejection of claim 1 under 35 USC 102(e) as being anticipated by Uneo has been withdrawn.

***Claim Rejections - 35 USC § 103***

9. The rejection of claims 1 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Woong Sang Jahng et al., Synthesis and Characterization of Hole-transport

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Materials in Polysiloxane, *Mat. Cryst. Liq. Cryst.*, Vol. 377 pp. 329-332 (Jahng) in view of Japanese Patent 10-333195 (Hisaya), US 2,774,697 (Koblitz) and applicant's admission is maintained. Applicant's arguments filed 20 October 2005 have been fully considered but they are not persuasive.

Applicant argues that Wright et al., Photoreactive Properties of Poly(siloxane)-triarylamine-Based Composites for High-Speed Applications, *J. Phys. Chem. B*, 2003, 107, 4732-4737 (Wright) teaches that the polymers taught by Jahng have too low a  $T_g$  to be effective; However, the polymers taught by Jahng alone are not at issue as it is the composition taught from the combined teachings of Jahng, Hisaya, Koblitz and applicant's admission—including a polymer with the backbone chain as taught by Jahng and the pendant group as taught by Hisaya—that render claims 1 and 13 unpatentable under 35 U.S.C. § 103(a). Had a  $T_g$  been claimed, one of ordinary skill in the art at the time the invention was made would have expected that the  $T_g$  of the Jahng, Hisaya, Koblitz and applicant's admission composition would inherently be the same as claimed and avoid the low  $T_g$  issue mentioned by Wright.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DAVID J. BUTTNER  
PRIMARY EXAMINER

TJK  
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*David J. Buttner*